

<b>TO: Mail Stop 8</b> <b>Director of the U.S. Patent and Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<b>REPORT ON THE</b> <b>FILING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR TRADEMARK</b>
---	---


In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court San Diego on the following Patents or Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
08-CV-1729-JAH-LSP	09/23/2008	Southern District of California
PLAINTIFF	DEFENDANT	
eBioscience Corporation	Invitrogen Corporation et al	
<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>
1 See complaint 6,423,551	6	11
2 6,699,723 6,927,069	7	12
3	8	13
4	9	14
5	10	15

In the above-entitled case, the following patent(s)/trademark(s) have been included:

DATE INCLUDED	INCLUDED BY			
	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill	<input type="checkbox"/> Other Pleading
<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>	<b>PATENT OR TRADEMARK NO.</b>
1	6		11	
2	7		12	
3	8		13	
4	9		14	
5	10		15	

In the above-entitled case, the following decision has been rendered or judgment issued:

DECISION/JUDGMENT		
		
CLERK	(BY) DEPUTY CLERK	DATE
W. Samuel Hamrick, Jr.	<i>W. Hamrick</i>	9/24/08

## DISCUSSION

Defendants move to dismiss the complaint pursuant to Federal Rule of Civil Procedure 12(b)(1) for lack of subject matter jurisdiction. Alternatively, Defendants move to dismiss the complaint pursuant to Federal Rule of Civil Procedure 19 for failure to join the Regents, which they claim to be a necessary and indispensable party.<sup>2</sup>

### **I. Legal Standard - Subject Matter Jurisdiction**

In deciding whether the Court has subject matter jurisdiction over declaratory relief actions for non-infringement, Federal Circuit law applies. Shell Oil Co. v. Amoco Corp., 970 F.2d 885, 888 n.3 (Fed. Cir. 1992). Plaintiff has the burden of establishing subject matter jurisdiction. Cedar-Sinai Medical Center v. Watkins, 11 F.3d 1573, 1583 (Fed. Cir. 1993). Where a party challenges the pleader's allegations of jurisdiction, "the allegations in the complaint are not controlling . . . and only uncontroverted factual allegations are accepted as true for purposes of the motion." Id. (internal citations omitted). "All other facts underlying the controverted jurisdictional allegations are in dispute and are subject to fact-finding by the district court." Id. at 1584. The court may review extrinsic evidence in determining the predicate jurisdictional facts. Id.

The Declaratory Judgment Act, in pertinent part, provides:

In a case of actual controversy within its jurisdiction ... any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought.

28 U.S.C. § 2201(a).

The availability of declaratory relief is limited by Article III of the Constitution, which restricts judicial power to the adjudication of "Cases" or "Controversies." U.S. Const. Art. III, § 2. "The existence of an actual controversy is an absolute prerequisite for declaratory judgment jurisdiction." Spectronics v. H.B. Fuller Co., 940 F.2d 631, 633-34 (Fed. Cir. 1991) (abrogated on other grounds by Liquid Dynamics Corp. v. Vaughan Co.,

---

<sup>2</sup> Because this Court finds subject matter jurisdiction to be lacking, this Court does not reach the issue of joinder.

1 Inc., 355 F.3d 1361, 1370 (Fed. Cir. 2004)); see 28 U.S.C. § 2201(a). For there to be a  
2 case or controversy under Article III, the dispute must be “definite and concrete, touching  
3 the legal relations of parties having adverse legal interests,” “real and substantial,” and  
4 “admi[t] of specific relief through a decree of a conclusive character, as distinguished from  
5 an opinion advising what the law would be upon a hypothetical state of facts.”  
6 MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 126 (2007) (quotations omitted).

7 Prior to the Supreme Court’s decision in MedImmune, the Federal Circuit applied  
8 a two prong test in determining subject matter jurisdiction in declaratory judgment cases,  
9 requiring a reasonable apprehension of suit. See Teva Pharm. USA, Inc. v. Pfizer, Inc.,  
10 395 F.3d 1324, 1333 (Fed. Cir. 2005). The United States Supreme Court, in  
11 MedImmune, rejected the Federal Circuit’s two prong test. MedImmune, 549 U.S. at  
12 132, n. 11. The Supreme Court ruled there is no bright-line rule for determining whether  
13 an action satisfies the case or controversy requirement. Id., at 126. Rather, post-  
14 MedImmune, “[t]he difference between an abstract question and a ‘controversy’  
15 contemplated by the Declaratory Judgment Act is necessarily one of degree, and it would  
16 be difficult . . . to fashion a precise test for determining in every case whether there is such  
17 a controversy.” Prasco, LLC v. Medicis Pharm. Corp., 537 F.3d 1329,1336 (Fed. Cir.  
18 2008) (quoting Maryland Cas. Co. v. Pac. Coal & Oil Co., 312 U.S. 270, 273 (1941)).

19 In analyzing subject matter jurisdiction, “the analysis must be calibrated to the  
20 particular facts of each case.” Cat Tech LLC v. TubeMaster, Inc., 528 F.3d 871, 879 (Fed.  
21 Cir. 2008). The question is whether “the facts alleged, under all the circumstances, show  
22 that there is a substantial controversy, between parties having adverse legal interests, of  
23 sufficient immediacy and reality to warrant the issuance of a declaratory judgment,”  
24 MedImmune, 549 U.S. at 126 (quoting Maryland Cas. Co., 312 U.S. at 273); see also  
25 Caraco Pharm. Labs. Ltd. v. Forest Labs., 527 F.3d 1278, 1290 (Fed. Cir. 2008).

26 An Article III controversy is found where a plaintiff has demonstrated an  
27 injury-in-fact caused by the defendant that can be redressed by the court. See Lujan v.  
28 Defenders of Wildlife, 504 U.S. 555, 560-61 (1992). A controversy may arise from either

1 an actual or an imminent injury. Id. at 563. When circumstances are taken as a whole to  
2 establish controversy, jurisdiction will be proper even when individual grounds alleging an  
3 “actual controversy” standing alone might not be sufficient. Teva Pharm. USA Inc. v.  
4 Novartis Pharm. Corp., 482 F.3d 1330, 1341 (Fed. Cir. 2007).

## 5           2.     **Analysis**

6           Defendants move to dismiss on the grounds that subject matter jurisdiction is  
7 lacking in this case because Plaintiff has not demonstrated an actual controversy under  
8 Article III. Plaintiff, in opposition, contends the following facts, when taken in the  
9 aggregate, demonstrate that a controversy exists between Plaintiff and Defendants: (A)  
10 Defendants have sued Plaintiff’s licensor in the Federal District Court for the Eastern  
11 District of Texas; and (B) Defendants have refused to offer a covenant not to sue Plaintiff.  
12 For the reasons discussed below, this Court finds these facts insufficient to raise a  
13 controversy within the meaning of Article III.

### 14           A.     **The Texas Action**

15           Plaintiff contends that Defendants’ assertion of the Patents-in-Suit against  
16 Plaintiffs’s licensor, Evident, coupled with Defendants’ inclusion of “Doe defendants” in  
17 that suit gives rise to an actual controversy within the meaning of Article III. Doc. No. 21  
18 at 6-8.

19           It is uncontested that Evident is the licensor of Plaintiff and that Plaintiff’s eFluor®  
20 products incorporate technology provided by Evident that is also used in Evident’s EviTag  
21 and EviFluor products. It is also uncontested that Defendants have sued Evident in the  
22 Eastern District of Texas, claiming that EviTag and EviFluor infringe upon Defendants’  
23 Patents-in-Suit, and that Defendants have included several “Doe defendants” in the Texas  
24 action. Using syllogistic reasoning, Plaintiff contends that because Defendants believe  
25 EviTag and EviFluor infringe on their patents and Plaintiff’s products are based on the  
26 same technology as EviTag and EviFluor, it necessarily follows that Defendants must  
27 believe Plaintiff’s products infringe on Defendants’ patents. Doc. No. 21 at 3.

28 ///

1 Further, Plaintiff assumes that the inclusion of "Doe defendants" in the Texas  
 2 action demonstrates Defendants' intent to sue other entities for infringing their patents  
 3 in connection with Evident. Plaintiff asserts that because Defendants necessarily believe  
 4 Plaintiff's product infringes their patent, and the product is based on technology provided  
 5 by Evident, Plaintiff claims it is the most likely entity to be considered as a "Doe  
 6 defendant". Id. at 8. Thus, Plaintiff contends this places Plaintiff in apprehension that  
 7 it will be sued for infringing Defendants' patents.<sup>3</sup> Id.

8 Defendants argue that Plaintiff's fear of being sued is not sufficient to raise an  
 9 Article III controversy. Defendants contend that while the MedImmune decision rejected  
 10 the "reasonable apprehension of suit" test in favor of a totality of circumstances test, it did  
 11 not alter authority that the filing of a lawsuit against a third party is insufficient to  
 12 establish subject matter jurisdiction. Doc. No. 22 at 4 (citing Teva Pharm. USA, Inc. v.  
 13 Pfizer, Inc., 395 F.3d 1324 (Fed. Cir. 2005); Sherwood Med. Indus. v. Deknatel, Inc., 512  
 14 F.2d 724 (8th Cir. 1975)). Defendants further contend that post-MedImmune, the  
 15 Federal Circuit has not had an opportunity to specifically rule whether a defendant's suit  
 16 against a third party could give rise to a controversy, but that extending jurisdiction in  
 17 such circumstances would not comply with the requirement that a plaintiff for declaratory  
 18 relief be faced with a threat that is "real, imminent, and traceable to defendants" Doc. No.  
 19 22 at 4 (citing Prasco, LLC v. Medicis Pharm. Corp., 537 F.3d 1329,1339-40 (Fed. Cir.  
 20 2008)). Defendants argue that because they have taken no action directed at Plaintiff, no  
 21 controversy can exist between the two. Doc. No. 22 at 3-4.

22 This Court agrees with Defendants. The record reflects that Defendants have taken  
 23 no action directed towards Plaintiff at all. In this regard, the cases which have found  
 24 actual controversy are highly distinguishable. Since MedImmune, the Federal Circuit has

---

25  
 26 <sup>3</sup>Plaintiff also contends it is now placed in a position of "pursuing arguably illegal behavior" Doc.No.  
 27 21 at 7 (citing AG Leader Tech., Inc. v. NTech Indus., Inc., 574 F. Supp. 2d 1011, 1018 (S.D. Iowa 2008)).  
 28 Defendants point out correctly that AG Leader is not binding authority on this Court. However, this Court  
 finds that even if AG Leader were binding, the factual dissimilarities sufficiently distinguish it from the  
 present case. The product for which AG Leader was seeking a declaratory judgment was the same product  
 at issue in Ntech's suit against AG Leader's supplier. Id. at 1013. Here, the products are not the same, they  
 are alleged to "share technical similarities." Doc. No. 1 at 3.

1 found an actual controversy where the defendants and plaintiffs seeking declaratory  
 2 judgments had engaged in a history of discussions regarding licensing, or patent validity,  
 3 or had sent warning letters, or had previously been involved in litigation with one another  
 4 in a patent case. See, e.g., SanDisk Corp. v. STMicroelectronics, Inc., 480 F.3d 1372  
 5 (Fed. Cir. 2007); Sony Electronics, Inc. v. Guardian Media Technologies, Ltd., 497 F.3d  
 6 1271 (Fed. Cir. 2007); Micron Tech., Inc. v. Mosaid Techs., Inc., 518 F.3d 897 (Fed. Cir.  
 7 2008). In each of those cases there was some direct interaction between plaintiff and  
 8 defendant prior to the filing of an action for a declaratory judgment. Here, there was  
 9 none. Taken alone, the fact that Defendants have sued a third party licensor of Plaintiff  
 10 for infringement does not give rise to a threat of imminent harm to Plaintiff fairly traceable  
 11 to Defendants.

#### 12 B. Silence As To Future Intention

13 Plaintiff contends that Defendants' silence as to any future intention toward  
 14 Plaintiff is an important factor to consider in determining whether an actual controversy  
 15 exists. Doc. No. 21 at 7. (citing to Prasco, 537 F.3d at 1341). The Prasco court explained  
 16 that:

17 A patentee has no obligation to spend the time and money to test a  
 18 competitors' product nor to make a definitive determination, at the  
 19 time and place of the competitors' choosing, that it will never bring an  
 20 infringement suit. And the patentee's silence does not alone make an  
 21 infringement action or other interference with the plaintiff's business  
 imminent. Thus, though a defendant's failure to sign a covenant not to  
 sue is one circumstance to consider in evaluating the totality of the  
 circumstances, it is not sufficient to create an actual controversy--some  
 affirmative actions by the defendant will also generally be necessary.

22 Prasco, 537 F.3d at 1341.

23 Defendants, in this case, have no obligation to commit to any course of action.  
 24 While Defendants' silence may raise Plaintiff's subjective concern that Defendants may  
 25 at some point decide to bring suit, such a subjective concern is not sufficient to give rise  
 26 to a case or controversy.

27 ///

28 ///

1 Further, Defendants point out that, as in Prasco, Plaintiff has forged ahead with the  
2 release and sale of its product. As the court in Prasco noted, "any uncertainty has not  
3 been paralyzing. To the contrary, notwithstanding this lawsuit, Prasco has launched its  
4 . . . product." Id. The same is true here. See Doc. No. 21 at Ex. 2.


5 This Court finds that neither Defendant's suit against Evident in Texas, nor  
6 Defendant's silence as to their future intentions regarding Plaintiff are sufficient alone to  
7 create a case or controversy. When added together, the facts are nonetheless insufficient  
8 to create a case or controversy. Therefore, this Court finds that Plaintiff has failed to meet  
9 its burden of establishing that an actual controversy exists between the parties and the  
10 complaint must be dismissed for lack of subject matter jurisdiction.<sup>4</sup>

11 **CONCLUSION AND ORDER**

12 Based on the foregoing, **IT IS HEREBY ORDERED** that:

- 13 1. Defendants' motion to dismiss the complaint [Doc. No. 17] pursuant to  
14 Rule 12(b)(1) is **GRANTED**; and  
15 2. Plaintiff's Complaint is **DISMISSED** for lack of subject matter jurisdiction.  
16

17 DATED: April 17, 2009

18   
19 JOHN A. HOUSTON  
20 United States District Judge  
21  
22  
23  
24  
25  
26

---

27 <sup>4</sup>This Court also notes that had it found subject matter jurisdiction to be proper in this case, it would  
28 likely have declined to hear the case under its discretionary powers. See Wilton v. Seven Falls Co., 515 U.S.  
277 (1995) (district courts possess discretion in determining whether and when to entertain an action under  
the Declaratory Judgment Act, even when the suit otherwise satisfies subject matter jurisdictional  
prerequisites.)

FILED

08 SEP 22 AM 11:31

CLERK, U.S. DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

DEPUTY

Richard A. Clegg (SBN 211213)  
SELTZER CAPLAN MCMAHON VITEK  
750 B Street, Suite 2100  
San Diego, California 92101  
Telephone: (619) 685-3086  
Facsimile: (619) 685-3100

*Of Counsel:*

Gary M. Butter (pending admission *pro hac vice*)  
Jeffrey D. Sullivan (pending admission *pro hac vice*)  
Lisa A. Chiarini (pending admission *pro hac vice*)  
Jennifer Cozeolino (pending admission *pro hac vice*)  
BAKER BOTTS L.L.P.  
30 Rockefeller Plaza, 44th Floor  
New York, New York 10112  
Telephone: (212) 408-2500  
Facsimile: (212) 408-2501

*Attorneys for Plaintiff,*  
eBIOSCIENCE CORPORATION

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF CALIFORNIA**

eBIOSCIENCE CORPORATION,

Plaintiff,

v.

INVITROGEN CORPORATION,  
QUANTUM DOT CORPORATION, and  
MOLECULAR PROBES, INC.,

Defendants.

**08 CV 1729 JAH LSP**  
Civil Action No. \_\_\_\_\_

**COMPLAINT FOR DECLARATORY  
JUDGMENT OF NON-INFRINGEMENT  
AND INVALIDITY OF U.S. PATENT NO.  
6,423,551, U.S. PATENT NO. 6,699,723, AND  
U.S. PATENT NO. 6,927,069**

**JURY TRIAL DEMANDED**



1 Plaintiff eBioscience Corporation ("eBioscience") alleges as follows for its Complaint for a  
2 Declaratory Judgment of Non-Infringement and Invalidity of U.S. Patent No. 6,423,551 (the "'551  
3 Patent"), U.S. Patent No. 6,699,723 (the "'723 Patent"), and U.S. Patent No. 6,927,069 (the "'069  
4 Patent") (collectively, the "Patents-in-Suit") against Defendants Invitrogen Corporation ("Invitrogen"),  
5 Quantum Dot Corporation ("QDC"), and Molecular Probes, Inc. ("Molecular Probes") (collectively,  
6 "Defendants"). All facts herein are alleged on information and belief, except those facts concerning  
7 the activities of eBioscience.

#### 8 NATURE OF THE ACTION

9 1. This is an action for declaratory relief arising under the Patent Act of the United States,  
10 35 U.S.C. § 100 *et seq.*, regarding non-infringement and invalidity of the '551 Patent, '723 Patent, and  
11 '069 Patent. Copies of the '551 Patent, '723 Patent, and '069 Patent are attached hereto as Exhibits A-  
12 C, respectively.

#### 13 PARTIES

14 2. Plaintiff eBioscience Corporation is a California corporation with its principal place of  
15 business in San Diego, California.

16 3. Defendant Invitrogen is a Delaware corporation, with its principal place of business at  
17 5791 Faraday Avenue, Carlsbad, California 92008.

18 4. Defendant QDC is a California corporation, with offices in Eugene, Oregon. QDC is a  
19 wholly owned subsidiary of Invitrogen.

20 5. Defendant Molecular Probes is an Oregon corporation, with offices in Eugene, Oregon.  
21 Molecular Probes is a wholly owned subsidiary of Invitrogen.

#### 22 JURISDICTION AND VENUE

23 6. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1338(a),  
24 2201, and 2202 because this action arises under the Patent Laws of the United States, and is based  
25  
26  
27

1 upon an actual controversy between eBioscience and Defendants regarding the non-infringement and  
2 invalidity of the Patents-in-Suit.

3 7. Defendants are subject to the personal jurisdiction of this Court because Defendants  
4 Invitrogen and QDC are incorporated in the State of California, because Defendants QDC and  
5 Molecular Probes are wholly owned subsidiaries of Invitrogen, and because Defendants QDC and  
6 Molecular Probes undertake pervasive contacts and activities with and involving Defendant Invitrogen  
7 and with other persons within this State.

8 8. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b), (c) and/or 28  
9 U.S.C. § 1400(b).

10 **FACTUAL BACKGROUND**

11 9. On July 23, 2002, the U.S. Patent and Trademark Office issued the '551 Patent entitled  
12 "Organo Luminescent Semiconductor Nanocrystal Probes For Biological Applications And Process  
13 For Making And Using Such Probes." Defendants claim to collectively hold a lawfully acquired  
14 exclusive license to the '551 Patent.

15 10. On March 2, 2004, the U.S. Patent and Trademark Office issued the '723 Patent entitled  
16 "Organo Luminescent Semiconductor Nanocrystal Probes For Biological Applications And Process  
17 For Making And Using Such Probes." Defendants claim to collectively hold a lawfully acquired  
18 exclusive license to the '723 Patent.

19 11. On August 9, 2005, the U.S. Patent and Trademark Office issued the '069 Patent  
20 entitled "Organo Luminescent Semiconductor Nanocrystal Probes For Biological Applications And  
21 Process For Making And Using Such Probes." Defendants claim to collectively hold a lawfully  
22 acquired exclusive license to the '069 Patent.

23 **STATEMENT OF OTHER PENDING ACTION**

24 12. On April 29, 2008, Defendants and their licensor filed a lawsuit against Evident  
25 Technologies, Inc. ("Evident") and against John Doe defendants 1 through 5, inclusive, in the United  
26 States.

1 States District Court for the Eastern District of Texas, Tyler Division, in an action styled *Invitrogen*  
2 *Corporation et al. v. Evident Technologies, Inc. et al.*, Case No. 6:08-CV-163 (the "Texas Action"),  
3 alleging infringement of the '551 Patent, '723 Patent, and '069 Patent.

4 **AN ACTUAL AND JUSTICIABLE CONTROVERSY EXISTS**

5 13. eBioscience and Evident are parties to a certain license agreement (the "Agreement")  
6 executed January 31, 2008 involving certain technology relating to what are known as "quantum dots"  
7 (the "Licensed Technology"). Since at least the time of execution of the Agreement, eBioscience has  
8 been and is making and using products pursuant to the Agreement that practice the Licensed  
9 Technology. These products share technical similarities with products Defendants are accusing of  
10 infringement in the Texas Action.

11 14. Defendants pursue litigation to enforce their purported intellectual property rights. In  
12 view of these facts, eBioscience has anticipated and expects that it would and will be accused by  
13 Defendants of alleged patent infringement in the near future as the result of its past and ongoing  
14 activities relating to the Licensed Technology in this District and elsewhere.

15 15. Thus, there is an actual and justiciable controversy between parties having adverse legal  
16 interests of sufficient immediacy and reality to warrant the issuance of a declaratory judgment, as to  
17 the non-infringement and invalidity of the '551 Patent, '723 Patent, and '069 Patent.

18 **FIRST CLAIM FOR RELIEF – NON-INFRINGEMENT**

19 16. eBioscience repeats and realleges the allegations set forth in preceding paragraphs 1-15  
20 as though fully set forth herein.

21 17. There exists an actual and justiciable controversy regarding the issue of infringement  
22 *vel non* of the '551 Patent, '723 Patent and '069 Patent between eBioscience and Defendants.  
23 Accordingly, eBioscience requests a judicial determination of its rights, duties, and obligations with  
24 regard to the '551 Patent, '723 Patent and '069 Patent.

1 18. eBioscience has not infringed and does not infringe any valid claim of the '551 Patent,  
2 '723 Patent, and '069 Patent.

3 19. A judicial declaration of non-infringement is necessary and appropriate so that  
4 eBioscience may ascertain its rights regarding the '551 Patent, '723 Patent, and '069 Patent.

5 **SECOND CLAIM FOR RELIEF – INVALIDITY**

6 20. eBioscience repeats and realleges the allegations set forth in preceding paragraphs 1-19  
7 as though fully set forth herein.

8 21. There exists an actual and justiciable controversy regarding the validity of the '551  
9 Patent, '723 Patent, and '069 Patent between eBioscience and Defendants. Accordingly, eBioscience  
10 requests a judicial determination of its rights, duties, and obligations with regard to the '551 Patent,  
11 '723 Patent, and '069 Patent.

12 22. The claims of the '551 Patent, '723 Patent and '069 Patent are invalid for failure to  
13 meet the conditions of patentability and/or otherwise comply with one or more of 35 U.S.C. §§ 100 *et*  
14 *seq.*, including 35 U.S.C. §§ 101, 102, 103, 112, and 116.

15 23. A judicial declaration of invalidity is necessary and appropriate so that eBioscience may  
16 ascertain its rights regarding the '551 Patent, '723 Patent, and '069 Patent.

17 **JURY DEMAND**

18 24. eBioscience demands a jury trial on all matters herein so triable.

19 **PRAYER FOR RELIEF**

20 WHEREFORE, eBioscience requests that the Court enter judgment in its favor and against  
21 Defendants as follows:

22 A. That eBioscience is not infringing and has not infringed any of the claims of the '551  
23 Patent, '723 Patent, and '069 Patent;

24 B. That each and every one of the claims of the '551 Patent, '723 Patent, and '069 Patent  
25 are invalid;


1 C. That Defendants be enjoined from bringing any action relating to or alleging  
2 infringement of the '551 Patent, '723 Patent, and/or '609 Patent against eBioscience;

3 D. As and to the extent that the pleadings and discovery herein establish that this case is an  
4 exceptional case within the meaning of 35 U.S.C. § 285, issuance of findings to this effect and entry of  
5 an Order entitling eBioscience to an award of reasonable attorneys' fees, expenses, and costs in this  
6 action; and

7 E. For such other and further relief that the Court deems just, reasonable and proper.

8  
9 Dated: September 22, 2008

Respectfully submitted,

10   
11 Richard A. Clegg (SBN 211211)  
12 SELTZER CAPLAN MCMAHON VITEK  
13 750 B Street, Suite 2100  
14 San Diego, California 92101  
15 Telephone: (619) 685-3086  
16 Facsimile: (619) 685-3100

17 *Of Counsel:*

18 Gary M. Butter (pending admission *pro hac vice*)  
19 Jeffrey D. Sullivan (pending admission *pro hac vice*)  
20 Lisa A. Chiarini (pending admission *pro hac vice*)  
21 Jennifer Cozeolino (pending admission *pro hac vice*)  
22 BAKER BOTTS L.L.P.  
23 30 Rockefeller Plaza, 44th Floor  
24 New York, New York 10112  
25 Telephone: (212) 408-2500  
26 Facsimile: (212) 408-2501

27 *Attorneys for Plaintiff,*  
28 eBIOSCIENCE CORPORATION

1  
2  
3  
4  
5  
6  
7  
8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA

10 eBIOSCIENCE CORPORATION,

11 Plaintiff,

12 v.

13 INVITROGEN CORPORATION,  
14 QUANTUM DOT CORPORATION,  
15 and MOLECULAR PROBES, INC.,

Defendants.

Civil No. 08cv1729 JAH(LSP)

ORDER GRANTING  
DEFENDANTS' MOTION TO  
DISMISS [Doc. No. 17] AND  
DISMISSING THE COMPLAINT  
[Doc. No. 1] IN ITS ENTIRETY.

16 INTRODUCTION

17 Defendants Invitrogen Corporation, and its wholly-owned subsidiaries, Quantum  
18 Dot Corporation and Molecular Probes, Inc. (collectively "Defendants") have filed a  
19 motion to dismiss the complaint filed by plaintiff eBioscience Corporation ("Plaintiff")  
20 pursuant to Federal Rule of Civil Procedure 12(b)(1) for lack of subject matter jurisdiction.  
21 The matter has been fully briefed by all parties. After a careful consideration of the  
22 pleadings and relevant exhibits presented, and for the reasons set forth below, this Court  
23 **GRANTS** Defendants' motion in its entirety and **DISMISSES** the complaint in its  
24 entirety as to all Defendants for lack of subject matter jurisdiction.

25 ///

26 ///

27 ///

28 ///

1 BACKGROUND<sup>1</sup>

2 Plaintiff seeks, through the instant complaint filed September 22, 2008, a  
3 declaratory judgment of non-infringement with respect to three United States Patents:  
4 Nos. 6,423,551 ("the 551 patent"), 6,699,723 ("the 723 patent"), and 6,927,069 ("the  
5 069 patent") (collectively "the Patents-in-Suit"). The Patents-in-Suit involve "quantum  
6 dot" technology and are described as "Organo Luminescent Semiconductor Probes for  
7 Biological Applications and Process for Making and Using Such Probes." The Patents-in-  
8 Suit are held by the Regents of the University of California ("Regents"). Regents entered  
9 into an agreement with Defendants granting them exclusive license in the field of use for  
10 the Patents-in-Suit.

11 On April 29, 2008, Defendants and Regents filed suit in the United States District  
12 Court for the Eastern District of Texas, claiming infringement of the Patents-in-Suit  
13 against Evident Technologies, Inc. ("Evident"), which is not a party to this action.  
14 Defendants (Plaintiffs in the Texas action) specifically allege that Evident's products,  
15 EviTag and EviFluor, infringe the Patents-in-Suit. Evident licenses technology to Plaintiff,  
16 which incorporates the licensed technology in their product eFluor®. Plaintiff avers that  
17 their products "share technical similarities" with the products at issue in the Texas action.  
18 Doc. No. 1 at 3.

19 The instant complaint seeks a declaration of non-infringement. Defendants filed  
20 their motion to dismiss the complaint on October 14, 2008. Plaintiff filed an opposition  
21 on November 24, 2008, and Defendants filed a reply brief on December 1, 2008. This  
22 Court subsequently took the motion under submission without oral argument. See Civ.LR  
23 7.1(d.1).

24 ///

25 ///

26 ///

27 \_\_\_\_\_  
28 <sup>1</sup> These uncontested background facts are taken directly from the parties' pleadings and exhibits attached thereto.